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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,556	03/21/2001	Eiichi Ito	108863	2650

25944 7590 09/17/2004

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EXAMINER
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LUGO, CARLOS

ART UNIT	PAPER NUMBER
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3676

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/812,556

Applicant(s)

ITO ET AL.

Examiner

Carlos Lugo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 6/1/04.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-12, 14, 15 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Office Action is in response to applicant's RCE filed on June 1, 2004.

#### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12,14,15 and 17, drawn to an automated personalized product producing system, classified in class 705, subclass 27.
- II. Claims 13 and 16, drawn to a method of providing a personalized product, classified in class 705, subclass 26.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions in Group I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed (the personalized product) can be made by another and materially different process like a manually operated process that manually input the order to the product producing device in order to produce the product.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

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4. If the applicant elects to prosecute the invention presented in Group I, then this application further contains claims directed to the following patentably distinct species of the claimed invention:

- Specie 1: Figures 1-18.
- Specie 2: Figures 19-33.
- Specie 3: Figures 34-36.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1,4,10 and 12 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is

the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. During a telephone conversation with Mr. Scott Schulte on September 7, 2004, a provisional election was made with oral traverse to prosecute the invention of Group II, claims 13 and 16. Applicant in replying to this Office action must make affirmation of this election. Claims 1-12, 14, 15, and 17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 13 and 16 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Rubber Stamps.com (Rubber Stamps) as modified by US Pat No 6,134,548 to Gottsman et al (Gottsman), in view of US Pat No 6,594,642 to Lemchen and further in view of US Pat No 6,161,099 to Harrington et al (Harrington).

Regarding claim 13, Rubber Stamps discloses a method of providing a personalized product in response to each request from customers. The method comprises the steps of:

A) Receiving electronic personalized product producing data in first format and customer identification information (email order, Page 2).

B) Electronically sequentially storing sets of the personalized product producing data and the customer identification information, each set including a piece of personalized product producing data and a piece of customer identification information (every time an user enter their information in the website).

However, Rubber Stamps fails to disclose that the method comprises the steps of:

- a) The data is received by a wireless communication.
- b) Electronically analyzing each piece of electronic personalized product producing data in the first format and converting it to a piece of electronic data in a second format.
- c) Receiving the piece of data in a second format and recording the piece of data in the second format on an output medium used to produce a personalized product.
- d) Automatically notifying the customer of completion of the personalized product requested.

Regarding the limitation presented in "a", Gottsman teaches that it is well known in the art to use a wireless communication in order to shop or communicate.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a wireless communication, as taught by Gottsman, into a system as described by Rubber Stamps, in order to give the customer with different ways to be connected with the system.

As to the limitation presented in "b and c", Rubber Stamps discloses that the company can receive an email of the product and the company will create it. However, Rubber Stamps does not disclose the process from receiving the email to the final product.

Lemchen teaches that it is well known in the art to have an electronic data analyzer (50) that receives customize data from a web server (60). This data is then converted into electronic data (machine codes) that the personalized product-producing device (10) receives in order to create the product.

It would have been obvious to one ordinary skill in the art at the time the invention was made to have a an automated process, as taught by Lemchen, into a system as described by Rubber Stamps, in order to increase and to make agile the production.

As to the limitation presented in "d", Rubber Stamps discloses that that the company asks for the customer information, like postal address, phone number and email. However, Rubber Stamps fails to disclose that the company will send an email to notified that he product is completed.

Harrington teaches that is well known in the art to have an email transmitter to transmit an email to a customer when something is completed (when the auction is completed, an email will be sent to the customer to notified if he win or loose the auction, Col. 12 Lines 24-30).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a email returning device, as taught by Harrington, into a

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system as described by Rubber Stamps, in order to be polite and kind to the customer to report anything to him in order to have him back for further purchases (what is known in the art as Customer Service).

As to claim 16, Rubber Stamps discloses the step of delivering the personalized product produced to a location designated by each piece of customer identification information.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lugo whose telephone number is 703-305-9747. The examiner can normally be reached on 9-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.

C.L.

Carlos Lugo  
AU 3676

September 7, 2004.



DANIEL P. STODOLA  
SUPERVISORY PATENT EXAMINER  
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